IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chen et al**	§	
	§	Group Art Unit: **2175**
Serial No.: **10/617,529**	§	
	§	Examiner: **Vu, Thanh T.**
Filed: **July 10, 2003**	§	
	§	Confirmation No.: **3582**
For: **Method and Apparatus for Modification of Pointing Device Functions in Conjunction with Dynamic Sorting, Displaying, Listing, and Activation**	§ §	

54105

Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on January 16, 2009.

A fee of $540.00 is required for filing an Appeal Brief. Please charge this fee to Lenovo Deposit Account No. 50-3533. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to Lenovo Deposit Account No. 50-3533. If, however, an additional extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Lenovo Deposit Account No. 50-3533.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: Lenovo (Singapore) PTE LTD. of Singapore 486048, Singapore.

<u>RELATED APPEALS AND INTERFERENCES</u>

This appeal has no related proceedings or interferences.

<div style="text-align:center">**STATUS OF CLAIMS**</div>

A.   TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are: 1-64

B.   STATUS OF ALL THE CLAIMS IN APPLICATION

Claims canceled: 7, 26

Claims withdrawn from consideration but not canceled: 39-64

Claims pending: 1-6, 8-25, and 27-38

Claims allowed: None

Claims rejected: 1-6, 8-25, and 27-38

Claims objected to: None

C.   CLAIMS ON APPEAL

The claims on appeal are: 1-6, 8-25, and 27-38

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection on October 21, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

A.   CLAIM 1 - INDEPENDENT

The subject matter of claim 1 is directed to a programmable apparatus for modifying a drop down menu program, comprising: (Page 5, lines 2-5; Page 10, lines 1-11; FIG. 6 and FIG. 7)

a computer having a memory, the memory containing a drop down menu program, a configuration table, and a configuration processor; (Page 10, line 13-Page 11, line 7; Page 16, lines 12-18; FIG. 7 and FIG. 16)

wherein the drop down menu program displays menu items in a drop down menu and is modified in accordance with the configuration table to eliminate one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting any text or menu item on the drop down menu, scrolling through the drop down menu, or sorting items in the drop down menu; (Page 5, lines 1-14; Page 16, line 19-Page 17, line 5 and Table 1)

wherein the configuration table comprises a plurality of pointer operations and a plurality of user selectable operation modes that correspond to the plurality of pointer operations; (Page 16, line 19-Page 17, line 5 and Table 1)

wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button; and (Page 16, line 19-Page 17, line 5 and Table 1)

wherein the configuration processor detects a change in the configuration table in response to a user selection of a selectable mode and distributes the change to the drop down menu program; (Page 16, lines 12-18, FIG. 15 and FIG. 16)

wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action. (Page 16, line 19-Page 17, line 5 and Table 1)

B.   CLAIM 20 - INDEPENDENT

The subject matter of claim 20 is directed to a program product operable on a computer, the program product comprising: (Page 10, line 1- Page 11 line 7; FIG. 6 and FIG. 7)

a computer-usable medium; (Page 10, lines 15- 19; FIG. 6 and FIG. 7)

a drop down menu program for the display of menu items in a drop down menu wherein the drop down menu program, in accordance with a configuration table, eliminates one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting a text or menu item on the drop down menu, scrolling through the drop down menu, or sorting a plurality of items in the drop down menu, the drop down, and wherein the drop down menu program, the configuration table and a configuration processor are stored in the computer-usable medium; (Page 5, lines 1-14; Page 10, lines 15- 19; Page 16, line 12-Page 17, line 5; Table 1; FIG. 15 and FIG. 16)

wherein the configuration table comprises a plurality of pointer operations and a plurality of user selectable operation modes that correspond to the plurality of pointer operations; (Page 16, line 19-Page 17, line 5 and Table 1)

wherein a first pointer operation is pointer-over and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button; and (Page 16, line 19-Page 17, line 5 and Table 1)

wherein the computer-usable medium, so configured by the configuration processor, causes a computer to detect a change in the configuration table in response to a selection of an operation mode by a user and to distribute the change to the drop down menu program; and (Page 10, lines 15- 19; Page 16, lines 12-18; FIG. 15 and FIG. 16)

wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action. (Page 16, line 19-Page 17, line 5 and Table 1)

C.   CLAIM 4 - DEPENDENT

The subject matter of claim 4 is directed to the programmable apparatus of claim 1 wherein the configuration table has a scrolling operation. (Page 16, line 19-Page 17, line 5; Table 1 and FIG. 16)

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

A.   GROUND OF REJECTION 1

Whether the Examiner properly rejected claims 1-6, 8-25, and 27-38 under 35 U.S.C. §103(a) as being unpatentable over Miura et al., U. S. Patent No. 7,246,329 (hereinafter "Miura") in view of Kirlay et al., U. S. Patent No. 6,249,606 (hereinafter "Kirlay") and further in view of Bauersfeld, U. S. Patent No. 5,917,491 (hereinafter "Bauersfeld").

ARGUMENT

A.   GROUND OF REJECTION 1 (Claims 1-6, 8-25, and 27-38)

The Examiner has rejected claims 1-6, 8-25, and 27-38 under 35 U.S.C. §103(a) as being unpatentable over Miura et al., U. S. Patent No. 7,246,329 (hereinafter "Miura") in view of Kirlay et al., U. S. Patent No. 6,249,606 (hereinafter "Kirlay") and further in view of Bauersfeld, U. S. Patent No. 5,917,491 (hereinafter "Bauersfeld"). This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka,* 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are… determined; differences between the prior art and the claims at issue are… ascertained; and the level of ordinary skill in the pertinent art resolved.

Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). "*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.* Id. (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006))."

A.1.   GROUP A – CLAIMS 1 AND 20 – INDEPENDENT: The Proposed Combination Fails to Teach or Suggest Each and Every Feature of Independent Claim 1 and Claim 20

The Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness in the present case because the proposed combination of references, considered as a

whole, does not teach or suggest all the limitations of Claim 1. For example, the proposed combination of references does not teach or suggest the following features:

a) "wherein the drop down menu program displays menu items in a drop down menu and is modified in accordance with the configuration table to eliminate one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting any text or menu item on the drop down menu, scrolling through the drop down menu, or sorting items in the drop down menu;"

b) "wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button;" and

c) "wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action."

Claim 1 is representative of claim 20, and the same arguments made for Claim 1 apply to claim 20.

A.1.a. The Proposed Combination Fails to Teach or Suggest "wherein the drop down menu program displays menu items in a drop down menu and is modified in accordance with the configuration table . . ."

The proposed combination of references fails to teach or suggest "wherein the drop down menu program displays menu items in a drop down menu and is modified in accordance with the configuration table to eliminate one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting any text or menu item on the drop down menu, scrolling through the drop down menu, or sorting items in the drop down menu." The Examiner cites to Miura Figures 1 and 7; column 12, lines 49-54; and column 21, lines 1-17 and 25-35, reproduced below:
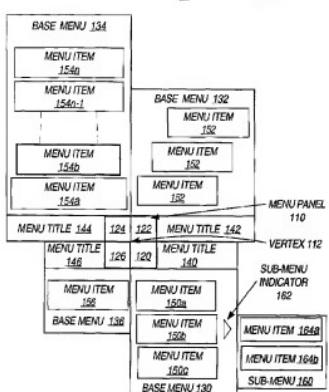
FIG. 1
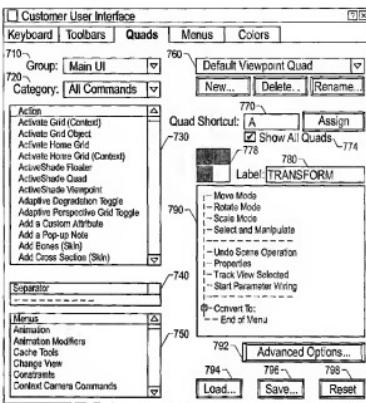
FIG. 7

According to one embodiment, a menu panel is in the form of a square that is comprised of four selection regions, each located in one quadrant of the square. For example, menu panel 110 and selection regions **120, 122, 124, 126** of FIG. 1 illustrate one implementation of this square approach for displaying menu panels and selection regions.

...

FIG. 7 is an illustration of user interface customization dialog box for multiple menus, according to one embodiment of the invention. Although FIG. 7 illustrates a multiple menu in the form of a quad menu with certain menu items and options that correspond to a 3D graphics application, other implementations are not limited to the quad menu format with the menu items and options for a 3D graphics application as illustrated in FIG. 7, nor are other implementations required to have all or any of the features illustrated in FIG. 7.

FIG. 7 depicts a dialog box 700 for customizing a quad menu that includes a variety of tools and objects for the user to provide input that may be used to supply filter data to define a display filter. Dialog box 700 includes a group object 710, a category object 720, a command list object730, a separator object 740, a base menu type selection object 750, a quad menu selection object 760, a quad shortcut object 770, a "show all quads" object 774, a selection region selector object 778, a label object 780, a base menu object 790, an advanced options object

792, a load object 794, a save object 796, and a reset object 798. The user
specifies which group of the user interface that is to be customized using group
object 710. As depicted in FIG. 7, the "Main U.I." group is selected.
…
Base menu type selection object 750 is used to specify which base menu is to be
modified, and quad menu selection object 760 is used to specify which quad menu
is to be modified. As depicted in FIG. 7, the "Default Viewport Quad" menu is
selected in quad menu selection object 760. Quad shortcut object 770 allows the
user to specify a hot key or keys for the quad menu, and "show all quads" object
774 allows the user to specify whether or not all quads are to be displayed at the
same time for selected quad menu.

Miura, Fig. 1; Fig. 7; col. 12, ll. 49-54; col. 20, ln. 61-col. 21 ln.17; and col. 21 ll. 25-35.

Miura is directed at techniques for managing multiple menus with a graphical user
interface. See Miura, abstract. The above cited portion discloses a menu panel composed of four
selection regions, and a dialog box for customizing such a multiple menu display in the form of a
quad menu. All portions of a base menu may or may not be displayed at the same time. The
Examiner asserts that the above cited portions of Miura, specifically Figure 7, teach *allows the
user to customize the menu*." Office Action dated October 21, 2008, p. 3 (emphasis in original).

However, Miura does not teach or suggest the elements of claim 1. Claim 1 recites
"wherein the drop down menu program displays menu items in a drop down menu and is
modified in accordance with the configuration table." While the Examiner asserts Miura teaches
that a menu can be customized, the claim recites that "the drop down menu *program* . . . is
modified in accordance with the configuration table" (emphasis added). A drop down menu
program is not the same as a menu, because claim 1 recites both a drop down menu program and
menu items displayed in a drop down menu. Miura is silent regarding any modification of a drop
down menu program in accordance with a configuration table. Further, the Examiner admits that
Miura does not teach a drop down menu or that a drop down menu displays menu items in a drop
down menu but asserts that Bauersfeld does. However, Bauersfeld fails to make up for the
deficiencies of Miura because Bauersfeld also does not teach or suggest "wherein the drop down
menu program . . . is modified in accordance with the configuration table." Also, the use of
Bauersfeld as reference for this rejection is improper because Bauersfeld is non-analogous art, as
will be discussed in greater detail below.

Thus, Miura does not teach or suggest "wherein the drop down menu program displays

menu items in a drop down menu and is modified in accordance with the configuration table to eliminate one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting any text or menu item on the drop down menu, scrolling through the drop down menu, or sorting items in the drop down menu." Even if the combination of references could be made as asserted by the Examiner, the combination would not teach the presently claimed invention in claim 1, because the above discussed features believed to be disclosed by Miura are not taught or suggested. By implication, the Examiner admits that none of the other cited references teach or suggest this claimed feature. Consequently, claim 1 is not obvious in view of the proposed combination of the references because the features believed to be disclosed by the cited reference are not present. The Examiner failed to meet the burden of establishing a *prima facie* case of obviousness rejection against claim 1.

Therefore, it is respectfully urged that the rejection of claim 1 under 35 U.S.C. § 103(a) has been overcome.

A.1.b. The Proposed Combination Fails to Teach or Suggest "wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button"

The proposed combination of references fails to teach or suggest "wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button." The Examiner cites to Bauersfeld Figures 4a-4c and column 5, lines 45-55, reproduced below:

FIG. 4A

FIG. 4B
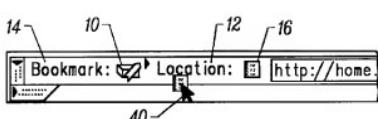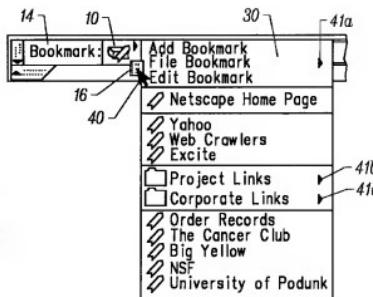
FIG. 4C

FIGS. *4a-4c* provide a schematic representation of a portion of a browser display showing a sequence of steps for using a page proxy for bookmarking URLs according to the invention. In FIG. *4a*, a cursor gesture **40** is used to drag a location proxy 16 from the location field 12 to the proxy icon **10** (FIG. *4b*). As a result, the bookmark button **10** is actuated, causing the bookmark menu 30 to drop down. The bookmark may then be dropped into an appropriate folder within the list of folders that appears in the bookmark menu, or within a folder in a sub-menu (as indicated by the arrows *41a-41c),* or an action may be taken (as discussed above).

Bauersfeld, Figs. 4a-4c; col. 5, ll. 45-55.

Bauresfeld is directed to managing web page locations in the form of URLs presented as web page bookmarks. See Bauresfeld, abstract. The above cited portions disclose that a cursor gesture is used to drag a location proxy to a bookmark menu.

The Examiner asserts that Bauersfeld teaches "wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button." However, nowhere in Bauersfeld is a teaching or suggestion present regarding a selectable operation mode or that any such operation mode corresponds to a pointer operation, for Bauresfeld is silent as to these features.

Thus, Bauersfeld does not teach or suggest "wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer

operation is activating a menu button." Even if the combination of references could be made as asserted by the Examiner, the combination would not reach the presently claimed invention in claim 1, because the above discussed features believed to be disclosed by Bauersfeld are not taught or suggested. By implication, the Examiner admits that none of the other cited references teach or suggest this claimed feature. Consequently, claim 1 is not obvious in view of the proposed combination of references because the features believed to be disclosed by the cited reference are not present. The Examiner failed to meet the burden of establishing a *prima facie* case of obviousness rejection against claim 1.

Therefore, it is respectfully urged that the rejection of claim 1 under 35 U.S.C. § 103(a) has been overcome.

> ### A.1.c. The Proposed Combination Fails to Teach or Suggest "wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action"

The proposed combination of references fails to teach or suggest "wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action." The Examiner cites to Bauersfeld Figures 4a-4c and column 5, lines 45-55, which are the same portions as reproduced in section **A.1.b.** above.

Examiner asserts that Bauersfeld teaches "*the pointer 40 is over the menu button 10 and the bookmark menu is activated or displayed without any other user action.*" Office Action dated October 21, 2008, p. 4 (emphasis in original). However, this assertion is incorrect because Bauersfeld, as quoted above, states that the bookmark button is actuated "as a result" of the cursor gesture **40** dragging the location proxy **16** from the location field **12** to the proxy icon. Thus, Bauersfeld appears to teach that a user perform an action to first drag the proxy location in order for any menu to drop down. Bauresfeld does not teach or suggest activation of a drop down menu simply by placing a pointer over a menu button, without any other user action.

Thus, Bauersfeld does not teach or suggest "wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action." Even if the

combination of references could be made as asserted by the Examiner, the combination would not reach the presently claimed invention in claim 1, because the above discussed features believed to be disclosed by Bauersfeld are not taught or suggested. By implication, the Examiner admits that none of the other cited references teach or suggest this claimed feature. Consequently, claim 1 is not obvious in view of the proposed combination of references because the features believed to be disclosed by the cited reference are not present. The Examiner failed to meet the burden of establishing a *prima facie* case of obviousness rejection against claim 1.

Therefore, it is respectfully urged that the rejection of claim 1 under 35 U.S.C. § 103(a) has been overcome.

A.2. GROUP B – CLAIMS 4, 17, 23 AND 36 – DEPENDENT: The Proposed Combination Fails to Teach or Suggest Each and Every Feature of Claim 4

The Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness in the present case because the proposed combination of references, considered as a whole, does not teach or suggest all the limitations of claim 4. For example, the proposed combination of references does not teach or suggest "wherein the configuration table has a scrolling operation." Claim 4 is representative of claims 17, 23 and 36, in that all claims recite "a scrolling operation."

The Examiner asserts that Bauersfeld, column 5, lines 37-45, as reproduced below, teaches all features of claim 4.

The bookmark button **10** drops down to reveal the bookmark menu 30. The bookmark menu provides a navigation aid that allows a list of hierarchically organized folders and sub-menus to be accessed and to provide a repository in which to drop a bookmark that has been dragged to the button 10. The bookmark menu also provides a list of actions that may be taken such as, for example "Add Bookmark," "File Bookmark," or "Edit Bookmark."

Bauersfeld, col 5, ll. 37-45.

As can be seen, these cited portions disclose a list of folders and menus that can be accessed and provide a repository in which to drop a bookmark. The bookmark menu also lists actions that can be taken such as adding, filing or editing a bookmark.

The Examiner states that this cited portion of the reference teaches a scrolling operation where "a user can scroll up and down within the dropdown menu to locate a drop position using the drag&drop command." Office Action dated October 21, 2008, p. 4. However, this assertion is incorrect. The reference does mention that folders and sub-menus can be accessed, but does not mention scrolling up and down within a dropdown menu. Nowhere in the cited reference is a scrolling operation disclosed, for Baurefeld is silent regarding such features.

Thus, Bauersfeld does not teach or suggest "wherein the configuration table has a scrolling operation." Even if the combination of references could be made as asserted by the Examiner, the combination would not reach the presently claimed invention in claim 4, because the above discussed features believed to be disclosed by Bauersfeld are not taught or suggested. By implication, the Examiner admits that none of the other cited references teach or suggest this claimed feature. Consequently, claim 1 is not obvious in view of the proposed combination of references because the features believed to be disclosed by the cited reference are not present. The Examiner failed to meet the burden of establishing a *prima facie* case of obviousness rejection against claim 4.

Therefore, it is respectfully urged that the rejection of claim 4 under 35 U.S.C. § 103(a) has been overcome.

A.3. GROUP C – CLAIMS 2-3, 5, 8-16, 18-19, 21-22, 24-25, 27-35 AND 37-38 – DEPENDENT

Claims 2-3, 5, 8-16, 18-19, 21-22, 24-25, 27-35 and 37-38 depend from and further restrict one of independent claims 1 and 20 and are also not obvious, at least by virtue of their dependency, for similar reasons discussed above with respect to claim 1. Therefore, it is respectfully urged that the rejection of claims 2-3, 5, 8-16, 18-19, 21-22, 24-25, 27-35 and 37-38 under 35 U.S.C. § 103(a) has been overcome.

A.4. Bauersfeld is Non-Analogous Art

The Examiner has failed to state a *prima facie* obviousness rejection because Bauersfeld is non-analogous art. In order to rely on a reference as a basis for rejection, the reference must be either in the applicant's field of endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986).

In the case at hand, Bauersfeld is not in the same field of endeavor as claim 1, and Bauersfeld is not reasonably pertinent to the particular problem with which Appellants are concerned. With regard to the first part of the test for analogous art, Bauersfeld is not in the same field of endeavor as claim 1 because Bauersfeld is in the field of web page proxy management. Bauersfeld, Abstract. In contrast, claim 1 is in the field of modifying pointing device functions. The two fields are completely distinct from each other because the methods and techniques taught by the two references are completely distinct from each other. Thus, Bauersfeld fails the first test of *In re Oetiker.*

With regard to the second part of the test for analogous art, Bauersfeld is not reasonably pertinent to the particular problem with which Appellants were concerned. As established above, Bauersfeld is in the field of web page proxy management. Specifically, Bauersfeld is directed to the problem of maintaining and categorizing web page bookmark information. For example, Bauersfeld provides that:

> It would be desirable to retain the ability within a browser for bookmarks to be easily acquired and revisited. It would also be desirable to provide more information to users when organizing and making sense of their bookmarks. It would further be desirable to provide quick, up front categorization of such bookmarks.

Bauersfeld, col. 1, ll. 29-35.

In contrast, claim 1 is directed to the problem of eliminating required manual user movements by modifying pointer functions. The problem addressed by Bauersfeld is completely distinct from the problem addressed by claim 1. For this reason, Bauersfeld is not reasonably

pertinent to the particular problem with which Appellants were concerned. Therefore, Bauersfeld fails the second part of the *In re Oetiker* test for analogous art.

Because Bauersfeld fails both tests presented in *In re Oetiker*, Bauersfeld is non-analogous art to claim 1. Accordingly, under the standards of *In re Oetiker*, Bauersfeld cannot be used as a reference vis-à-vis an obviousness rejection against claim 1. Hence, the Examiner failed to state a *prima facie* obviousness rejection against claim 1.

A.5. The Examiner Fails to State a Sufficient Reason to Combine the References

The Examiner failed to state a sufficient reason to modify Miura in view of Kirlay and Bauersfeld because the Examiner's proposed reason for modifying the cited art provides no rational underpinning to support a legal conclusion of obviousness.

In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated the following:

> Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1740-41 (2007).

Regarding a reason to modify Miura, the Examiner states that:

> Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kirlay and Bauersfeld in the invention of Miura in order to allow computer system to accept input data originating from a user in the form of gesture data that are made using a cursor directing device, and in order to conserve space in an application program by including drop-down menu.

Office Action dated October 21, 2008, page 4.

The Examiner offers an advantage unrelated to the present invention as the stated reason for modifying the teachings Miura in view of Kirlay and Bauersfeld in the manner proposed. Specifically, the Examiner proposes modifying the cited art because it would allow a computer to accept input data in the form of gesture data and conserve space in an application program. However, as claim 1 recites "the drop down menu program . . . is modified . . . to eliminate one or more manual movements required by a user when employing a user input device."

Further, the Examiner has merely a goal or desire and provided no express analysis combining the references. To meet this goal, the Examiner states it would have been obvious. Nowhere, however, has the Examiner gone beyond this conclusion or desired goal to explain sufficiently why one of ordinary skill in the art would have combined these three references. In particular, the Examiner does not provide any reason for modifying Miura in view of Kirlay and Bauersfeld to allow a computer system to accept input data in the form of gesture data in order to conserve space in an application program by including drop-down menu where neither Miura, Kirlay and Bauersfeld teach or suggest all the features of claim 1. The statements made by the Examiner do not provide reasons as required in the Supreme Court guidance on combining references in the KSR case.

Thus, the Examiner's reason for modifying Miura in view of Kirlay and Bauersfeld provides an insufficient basis for modifying the teachings of the cited art in the manner necessary to reach each and every feature of claim 1, especially in the light of the differences that exist between Miura in view of Kirlay and Bauersfeld and claim 1.

For these reasons, it is respectfully urged that the rejection of obviousness vis-à-vis claim 1 has been overcome.

C.   CONCLUSION

As shown above, the examiner has failed to state valid rejections against any of the claims. Therefore, Appellants request that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellants request that the Board direct the Examiner to allow the claims.

Date: March 16, 2009   Respectfully submitted,

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CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

1.   A programmable apparatus for modifying a drop down menu program, comprising:

a computer having a memory, the memory containing a drop down menu program, a configuration table, and a configuration processor;

wherein the drop down menu program displays menu items in a drop down menu and is modified in accordance with the configuration table to eliminate one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting any text or menu item on the drop down menu, scrolling through the drop down menu, or sorting items in the drop down menu;

wherein the configuration table comprises a plurality of pointer operations and a plurality of user selectable operation modes that correspond to the plurality of pointer operations;

wherein a first pointer operation is a pointer-over operation and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button; and

wherein the configuration processor detects a change in the configuration table in response to a user selection of a selectable mode and distributes the change to the drop down menu program;

wherein, responsive to the first pointer operation, when a user moves a pointer over the menu button on the drop down menu the menu button on the drop down menu is activated without any other user action.

2. The programmable apparatus of claim 1 wherein the configuration table has an activating operation.

3. The programmable apparatus of claim 1 wherein the configuration table has a selecting operation.

4. The programmable apparatus of claim 1 wherein the configuration table has a scrolling operation.

5. The programmable apparatus of claim 1 wherein the configuration table has a sorting operation.

6. The programmable apparatus of claim 1 wherein the configuration table has a recalling operation.

8. The programmable apparatus of claim 1 wherein the selectable mode is a pointer-over-with-clicking mode.

9. The programmable apparatus of claim 1 wherein the selectable mode is a pointer-movement mode.

10. The programmable apparatus of claim 1 wherein the selectable mode is a pointer-over-with-highlighting mode.

11.   The programmable apparatus of claim 1 wherein the selectable mode is a pointer-over-with-highlighting-and-clicking mode.

12.   The programmable apparatus of claim 1 further comprising a configuration editor.

13.   The programmable apparatus of claim 12 wherein the configuration editor is a graphical configuration editor.

14.   The programmable apparatus of claim 13 wherein the configuration editor has at least one operation control panel, the operation control panel having a plurality of selectable mode indicators.

15.   The programmable apparatus of claim 14 wherein the operation control panel is an activating control panel.

16.   The programmable apparatus of claim 14 wherein the operation control panel is a selecting control panel.

17.   The programmable apparatus of claim 14 wherein the operation control panel is a scrolling control panel.

18.   The programmable apparatus of claim 14 wherein the operation control panel is a sorting control panel.

19.   The programmable apparatus of claim 14 wherein the operation control panel is a recalling control panel.

20.   A program product operable on a computer, the program product comprising:

a computer-usable medium;

a drop down menu program for the display of menu items in a drop down menu wherein the drop down menu program, in accordance with a configuration table, eliminates one or more manual movements required by a user when employing a user input device for activating a button on the drop down menu, selecting a text or menu item on the drop down menu, scrolling through the drop down menu, or sorting a plurality of items in the drop down menu, the drop down, and wherein the drop down menu program, the configuration table and a configuration processor are stored in the computer-usable medium;

wherein the configuration table comprises a plurality of pointer operations and a plurality of user selectable operation modes that correspond to the plurality of pointer operations;

wherein a first pointer operation is pointer-over and wherein a first selectable operation mode corresponding to the first pointer operation is activating a menu button; and

wherein the computer-usable medium, so configured by the configuration processor, causes a computer to detect a change in the configuration table in response to a selection of an operation mode by a user and to distribute the change to the drop down menu program; and

wherein, responsive to the first pointer operation, when a user moves a pointer over the

menu button on the drop down menu the menu button on the drop down menu is activated without any other user action.

21.　　The program product of claim 20 wherein the configuration table has an activating operation.

22.　　The program product of claim 20 wherein the configuration table has a selecting operation.

23.　　The program product of claim 20 wherein the configuration table has a scrolling operation.

24.　　The program product of claim 20 wherein the configuration table has a sorting operation.

25.　　The program product of claim 20 wherein the configuration table has a recalling operation.

27.　　The program product of claim 20 wherein the operation mode is a pointer-over-with-clicking mode.

28.　　The program product of claim 20 wherein the operation mode is a pointer-movement mode.

29. The program product of claim 20 wherein the operation mode is a pointer-over-with-highlighting mode.

30. The program product of claim 20 wherein the operation mode is a pointer-over-with-highlighting-and-clicking mode.

31. The program product of claim 20 further comprising a configuration editor stored in the computer-usable medium.

32. The program product of claim 31 wherein the configuration editor is a graphical configuration editor.

33. The program product of claim 32 wherein the configuration editor has at least one operation control panel, the operation control panel having a plurality of selectable mode indicators.

34. The program product of claim 33 wherein the operation control panel is an activating control panel.

35. The program product of claim 33 wherein the operation control panel is a selecting control panel.

36.   The program product of claim 33 wherein the operation control panel is a scrolling control panel.

37.   The program product of claim 33 wherein the operation control panel is a sorting control panel.

38.   The program product of claim 33 wherein the operation control panel is a recalling control panel.

EVIDENCE APPENDIX

This appeal brief presents no additional evidence.

RELATED PROCEEDINGS APPENDIX

This appeal has no related proceedings.